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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,712	08/07/2003	Hiraku Murayama	011350-318	1927

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EXAMINER

FOREMAN, JONATHAN M

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/635,712

Applicant(s)

MURAYAMA ET AL.

Examiner

Jonathan ML Foreman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8/7/03;2/25/04</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statements filed 8/7/03 and 2/25/04 comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. They have been placed in the application file, and the information referred to therein has been considered by the examiner as to the merits.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1 and 2 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 of copending Application No. 10/634,845. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 2 of the current application are merely broader in scope than claim 2 of Application No. 10/634,845. Therefore, any reference that anticipates claim 2 of Application No. 10/634,845 would necessarily anticipate claims 1 and 2 of the current application.

3. Claims 1 and 2 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 12 of copending Application No. 10/635,716. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 2 of the current application are merely broader in scope than claim 12 of Application No. 10/635,716. Therefore, any reference that anticipates claim 2 of Application No. 10/635,716 would necessarily anticipate claims 1 and 2 of the current application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an

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application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 15 is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,465,733 to Hinohara et al.

In regards to claim 15, Hinohara et al. discloses a guide wire including a first wire being formed of a pseudo-elastic alloy and disposed on the distal side of the guide wire (Col. 5, lines 29 – 32); and a second wire formed of a Co-based alloy and being disposed on the proximal side of the first wire (Col. 5, lines 14 – 15); wherein the first and second wire are joined by welding (Col. 5, line 32).

6. Claims 1 – 6 and 8 - 13 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,957,865 to Backman et al.

In regards to claims 1 – 6 and 8 – 13, Backman et al. discloses a guide wire including first wire disposed on the distal side of the guide wire (Col. 6, lines 56 – 57); and a second wire disposed on the proximal side from the guide wire (Col. 4, line 55), the second wire having a rigidity higher than that of the first wire (Col. 5, lines 12 – 14; Col. 7, lines 8 – 11); wherein the first and second wire are joined by welding (Col. 6, lines 65 – 67); a welded portion has a projection (54) projecting the outer peripheral direction; the second wire has a first portion provided in the vicinity of the distal end to the second wire and a second portion provided on the proximal side from a first portion; the first portion has a rigidity lower than that of the second portion (Col. 6, lines 35 – 37). The enlarged portion of the weld allows for visualization under fluoroscopy. Backman et al. discloses a cover layer disposed over at least the welded portion (Col. 7, lines 17 – 21). A spiral coil (52) covers at least a distal end portion of the first wire. The proximal end of the coil abuts the projection (Figure 3). The proximal side and the distal side of the projection are formed into shapes asymmetric to each other with respect to the welded surface (Figure 3).

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7. Claims 1, 3, 4, 8, 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 6,001,068 to Uchino et al.

In regards to claims 1, 3, 4, 8, 10 and 11, Uchino et al. discloses a guide wire including first wire (A) disposed on the distal side of the guide wire; and a second wire (B) disposed on the proximal side from the guide wire, the second wire having a rigidity higher than that of the first wire; wherein the first and second wire are joined by welding (Col. 7, lines 62 – 63); a welded portion has a projection projecting the outer peripheral direction (Figure 3.2); the second wire has a first portion provided in the vicinity of the distal end to the second wire and a second portion provided on the proximal side from a first portion; the first portion has a rigidity lower than that of the second portion (Col. 8, line 35 – Col. 9, line 18). The enlarged portion of the weld allows for visualization under fluoroscopy. A spiral coil (112) covers at least a distal end portion of the first wire.

8. Claim 15 is rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Application Publication No. 2003/0069521 to Reynolds et al.

In regards to claim 15, Reynolds et al. discloses a guide wire including a first wire being formed of a pseudo-elastic alloy and disposed on the distal side of the guide wire [0056]; and a second wire formed of a Co-based alloy and being disposed on the proximal side of the first wire [0034]; wherein the first and second wire are joined by welding [0034].

9. Claims 1 – 4, 6 - 11, 13 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Application Publication No. 2003/0100847 to D'Aquanni et al.

In regards to claims 1 – 4, 6 - 9, 11, 13 and 14, D'Aquanni et al. discloses a guide wire including first wire (14) disposed on the distal side of the guide wire; and a second wire (11) disposed on the proximal side from the guide wire, the second wire having a rigidity higher than that of the first wire; wherein the first and second wire are joined by welding [0024]; a welded portion

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has a projection (19) projecting the outer peripheral direction; the second wire has a first portion provided in the vicinity of the distal end to the second wire and a second portion provided on the proximal side from a first portion; the first portion has a rigidity lower than that of the second portion [0025]. The enlarged portion of the weld allows for visualization under fluoroscopy.

D'Aquanni et al. discloses a cover layer disposed over at least the welded portion [0028]. A spiral coil (15) covers at least a distal end portion of the first wire. The proximal side and the distal side of the projection are formed into shapes asymmetric to each other with respect to the welded surface (Figure 1). D'Aquanni et al. discloses the first wire and the second wire having a thinned portion, and the projection being provided on the thinned portion (Figure 1).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent No. 5,813,997 to Imran et al. and US Patent No. 6,390,993 to Cornish et al.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (571)272-4724. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JMLF


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SENIOR PATENT EXAMINER
TECHNOLOGY CENTER 3700